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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/671,736	09/29/2000	Gregory T. Osterhout	11889RR/56130.000011	2264

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Hunton & Williams  
1900 K Street NW  
Washington, DC 20006-1109

EXAMINER
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RYMAN, DANIEL J

ART UNIT	PAPER NUMBER
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2665

DATE MAILED 08/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/671,736

Applicant(s)

OSTERHOUT ET AL.

Examiner

Daniel J. Ryman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: ref. 144 (see Fig. 5 and page 17, line 7-page 18, line 10). A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: ref. 200 (see page 11, line 27) and ref. 140 (see page 17, line 7). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. Examiner requests that Applicant update the application information seen on page 1, lines 9-19 in order to reflect any changes in the status of the applications.

### ***Claim Objections***

4. Claim 13 objected to because of the following informalities: “receiving a call initiation request via a first interface to a network-enabled telephone device” should be “receiving a call initiation request, via a first interface to a network-enabled telephone device”. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 6-9, 11-13, 18-21, 23, and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Thornton et al. (USPN 6,363,065).

7. Regarding claims 1 and 13, Thornton discloses a system for adaptively placing a call via one of a plurality of transmission modes, comprising: a first interface to a network-enabled telephone device (Fig. 1; col. 1, lines 8-21; col. 3, line 34-col. 4, line 6; and col. 9, line 9-col. 11, line 61); a second interface to at least one communications link (Fig. 1; col. 1, lines 8-21; col. 3, line 34-col. 4, line 6; and col. 9, line 9-col. 11, line 61); and a host, communicating with the first interface and the second interface, the host, after receiving a call initiation request via a first interface, selectively initiating a call from the network-enabled telephone device as at least one of a telephone call and a data connection via the at least one communications link according to at least one transmission criterion (Fig. 1; col. 1, lines 8-21; col. 3, line 34-col. 4, line 6; and col. 9, line 9-col. 11, line 61).

8. Regarding claims 6 and 18, referring to claims 1 and 13, Thornton discloses that the host comprises a computer (Fig. 1; col. 1, lines 8-21; col. 3, line 34-col. 4, line 6; and col. 9, line 9-col. 11, line 61) where, as broadly defined, the gateway (ref. 200) is a computer.

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9. Regarding claims 7 and 19, referring to claims 1 and 13, Thornton discloses that the at least one transmission criterion comprises at least one of cost, time of day, day of week, user-defined routing data, packet delay and signal to noise ratio (col. 3, line 34-col. 4, line 6; col. 6, line 61-col. 7, line 6; and col. 9, line 9-col. 11, line 61).

10. Regarding claims 8 and 20, referring to claims 1 and 13, Thornton discloses that the call comprises a telephone call and the at least one communications link comprises the public switched telephone network (Fig. 1; col. 1, lines 8-21; col. 3, line 34-col. 4, line 6; and col. 9, line 9-col. 11, line 61).

11. Regarding claims 9 and 21, referring to claims 1 and 13, Thornton discloses that the call comprises a data connection and the at least one communications link comprises the Internet (Fig. 1; col. 1, lines 8-21; col. 3, line 34-col. 4, line 6; and col. 9, line 9-col. 11, line 61).

12. Regarding claims 11 and 23, referring to claims 1 and 13, Thornton discloses that the host selectively retries at least a data connection to reassess transmission conditions (Fig. 1; col. 1, lines 8-21; col. 3, line 34-col. 4, line 6; and col. 9, line 9-col. 11, line 61).

13. Regarding claims 12 and 24, referring to claims 1 and 13, Thornton discloses that the at least one communications link comprises a plurality of communications links, and the host selectively activates one of the communications links according to the at least one transmission criterion (Fig. 1; col. 1, lines 8-21; col. 3, line 34-col. 4, line 6; and col. 9, line 9-col. 11, line 61).

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 2 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thornton et al. (USPN 6,363,065) as applied to claims 1 and 13 above, and further in view of Donovan (USPN 6,366,577).

16. Regarding claims 2 and 14, referring to claims 1 and 13, Thornton does not expressly disclose that the network-enabled telephone device comprises a SIP-enabled telephone device; however, Thornton does disclose that the network-enabled telephone device communicates over the internet (Fig. 1; col. 1, lines 8-21; col. 3, line 34-col. 4, line 6; and col. 9, line 9-col. 11, line 61). Donovan discloses that SIP is a protocol developed to handle call set-up when communicating over IP (col. 1, lines 39-42). It would have been obvious to one of ordinary skill in the art at the time of the invention to have the network-enabled telephone device comprises a SIP-enabled telephone device since SIP is a protocol developed to handle call set-up when communicating over IP.

17. Claims 3, 4, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thornton et al. (USPN 6,363,065).

18. Regarding claims 3 and 15, referring to claims 1 and 13, Thornton does not expressly disclose that the first interface comprises a USB connection; however, Thornton does disclose that "the interfaces to the gateway can be readily modified by anyone skilled in the art to accommodate a wide range of different telephone subscriber line types and speeds" (col. 63, lines 59-66). Examiner takes official notice that a USB connection is a very old and well-known way in the art to connect together two devices. It would have been obvious to one of ordinary

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skill in the art at the time of the invention to use a USB connection since USB connections are a very old and well known way in the art to connect together two devices.

19. Regarding claims 4 and 16, referring to claims 1 and 13, Thornton does not expressly disclose that the first interface comprises a wireless interface; however, Thornton does disclose that “the interfaces to the gateway can be readily modified by anyone skilled in the art to accommodate a wide range of different telephone subscriber line types and speeds” (col. 63, lines 59-66). Examiner takes official notice that wireless connections are very old and well known in the art since wireless connections enable greater mobility to a user. It would have been obvious to one of ordinary skill in the art at the time of the invention to have the first interface comprise a wireless interface since wireless connections enable greater mobility to a user.

20. Claims 5 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thornton et al. (USPN 6,363,065) as applied to claims 4 and 16 above, and further in view of Okada et al. (USPN 6,463,134).

21. Regarding claims 5 and 17, referring to claims 4 and 16, Thornton does not expressly disclose that the host comprises a Wireless Markup Language module; however, Thornton does disclose that a variety of data types can be exchanged with Thornton’s inventive system (voice, data, facsimile) (abstract). Okada discloses that XML is a well-known format for displaying email on a wireless device (col. 1, line 66-col. 2, line 6 and col. 17, lines 13-18). It would have been obvious to one of ordinary skill in the art at the time of the invention to have the host comprise a Wireless Markup Language module since XML is a well-known format for displaying email on a wireless device.

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22. Claims 10 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thornton et al. (USPN 6,363,065) as applied to claims 1 and 13 above, and further in view of Kuthyar et al. (USPN 5,768,513).

23. Regarding claims 10 and 22, referring to claims 1 and 13, Thornton does not expressly disclose a media management module, the media management module executing at least one of a cordless telephone operation, an answering machine operation, a pager operation, an intercom operation, and an audio/visual operation via the network-enabled telephone device; however, Thornton does disclose that various types of information can be communicated over various connections with Thornton's inventive system (col. 3, line 34-col. 4, line 6; col. 6, line 61-col. 7, line 6; col. 9, line 9-col. 11, line 61; and col. 63, lines 59-66). Kuthyar teaches using a media management module to execute an answering machine operation such that messages can be left for a called party (col. 1, line 64-col. 2, line 35). It would have been obvious to one of ordinary skill in the art at the time of the invention to have a media management module, the media management module executing at least one of a cordless telephone operation, an answering machine operation, a pager operation, an intercom operation, and an audio/visual operation via the network-enabled telephone device in order to allow messages to be left for a called party.

### ***Conclusion***

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Curry et al. (USPN 6,078,582) see entire document which pertains to determining whether a call should be completed on the PSTN or Internet depending on the call requirements of a particular call. Beyda et al. (USPN 5,995,607) see entire document which pertains to determining whether a call should be completed on the PSTN or Internet depending on the call



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requirements of a particular call. Farris (USPN 6,064,653) see entire document which pertains to routing a voice call over the PSTN during periods of unacceptable network conditions.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Ryman whose telephone number is (703)305-6970. The examiner can normally be reached on Mon.-Fri. 7:00-5:00 with every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on (703)308-6602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel J. Ryman  
Examiner  
Art Unit 2665

*DJR*  
Daniel J. Ryman



HUY D. VU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600